

REMARKS

Claims 37 and 40, which were not amended in Applicant's response dated November 8, 2005, stand as newly rejected under 35 USC § 112 as failing to comply with the written description requirement. According to the Office Action, these claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

In particular, the Office Action states that "Independent Claims 37 and 40 disclose wherein the third party is not one of (a) the plurality of parties to the dispute, (b) a judge, and (c) a juror; however, the specification never describes this negative limitation."

Applicant notes that dependent claims 38 and 39, which depend directly from claim 37, are not subject to this rejection. These claims add limitations regarding the "substantially real-time" interaction described in elements (b) and (c) of claim 37. Claim 38 recites that the interaction that involves a third party that is not one of (a) the plurality of parties to the dispute, (b) a judge, and (c) a juror (recited as element (c)) occurs at substantially the same time as the interaction directed towards resolving the dispute involving at least one of the parties to the dispute (recited as element (b)). Claim 39 recites that the substantial real time interaction, including the interaction that involves a third party that is not one of (a) the plurality of parties to the dispute, (b) a judge, and

(c) a juror (recited as element (c)) is displayed on at least a display. Thus, according to the Office Action, these dependant claims in fact do contain subject matter which was described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. Applicant, therefore, respectfully traverses this rejection, at least with respect to claim 37, based on the simple logic that if applicant had possession of the subject matter of dependent claims 38 and 39, then applicant must have had possession of the subject matter of independent claim 37.

Further, applicant additionally traverses this rejection based on the fact that from reading applicant's application, one skilled in the relevant art would reasonably understand that at the time the application was filed applicant had possession of the claimed invention. For example, in the Field of the Invention section of the application, a mere 15 lines into the application, it states that "the invention is also related to the field of entertainment, as it provides a novel approach to dispute resolution that, while providing a vehicle for parties to a dispute to obtain resolution, also provides a vehicle for others to get involved in resolving the dispute or to be entertained." Then, in the Background of the Invention section, the application states that "there is a constant need for educational, interactive, and/or enjoyable entertainment experiences, such as via the Internet." In the Summary of the Invention section, the application refers to "an audience viewing the dispute ("the gallery")." In the Detailed Description

section, the application states (page 4, lines 20-24) “the dispute resolution service is provided for free or for a very low fee, in exchange for the parties willingness to make the dispute open to the public. Here, the business model depends on advertising revenue based on the view that many people would be interested in seeing what other people are arguing about.” Applicant could continue pointing to portions of the specification and drawings to further bolster applicant's position. However, the above should be more than sufficient to support the notion that one of skill in the art would readily understand that, at the time the application was filed, applicant had possession of a third party not being a party to the dispute, a judge, or a juror. Applicant, therefore, respectfully requests that this rejection be reconsidered and withdrawn.

The Office Action also rejects claims 37 and 40 under 35 USC §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Oddly, in this case, the Office Action readily admits that “applicant has disclosed that the method/system described in Claims 37 and 40 include interaction with a third party that is not one of (a) the plurality of parties to the dispute, (b) a judge, and (c) a juror.” Thus, in the context of the §112, second paragraph rejection, the Office Action contradicts the premise of the §112, first paragraph rejection. This provides another basis for reconsideration and withdrawal of the §112, first paragraph rejection.

After admitting that Applicant has disclosed this subject matter, the Office

Action states that “the claims never clearly describe who/what the third party is.” Applicant respectfully disagrees. The claim clearly describes who the third party is by simply stating who the third party is not. In other words, the third party can be anybody who is not a party, a judge, or a juror. This is not indefinite. It is a set of people that starts with the universe of people, and then excludes a small number of people (parties, judge, juror). Not only is this clearly and definitely claimed, it is readily supported by the application as filed (see above discussion of the §112, first paragraph rejection). Applicant respectfully requests the Examiner to suggest a logical basis for why this is not readily apparent from the language of the claims.

Applicant also notes, once again, that dependent claims 38 and 39 are not subject to this rejection. The Office therefore recognizes, for some reason, that this subject matter is sufficiently definite when further restricted by having this interaction with a third party (i.e., anyone on the planet that is not a party, judge, or juror) occurring at substantially the same time, as interaction involving at least one of the parties. Further, the Office also appears to recognize that this subject matter is sufficiently definite when further restricted by having this interaction with a third party (i.e., anyone on the planet that is not a party, judge, or juror) displayed on at least one display. Applicant fails to understand the logic of the Office Action. However, Applicant has given up trying to decipher the logical basis for anything the Office does with respect to this application, given the Office’s extensive and piecemeal approach to this application.

Claims 37-40 stand rejected under 35 USC § 102 (a) as anticipated by NevadaBusiness.com, a new reference to this prosecution. All of the other claims are rejected as obvious under 35 USC § 103 by some combination of other references with this new reference. For example, claim 1 is rejected as obvious over NevadaBusiness.com in view of Herz. Claim 2 is rejected as obvious over the aforementioned references when further combined with Sloo. The rejection of claims 9 and 10 is based on Sloo and Siefert in combination with NevadaBusiness.com. Claims 23, 25-27, 29, 32 and 34-36 stand rejected over NevadaBusiness.com in view of Herz. Claim 24 is separately rejected over the exact same references. Claim 28 is rejected by the combination of NevadaBusiness.com with Herz and ZipLink. Finally, claims 8, 21, 22, 30 and 31 are rejected by combining NevadaBusiness.com with Herz, Sloo and Siefert.

The Office Action includes 11 pages that supposedly provide detailed bases for these rejections. However, a close reading of the Office Action shows that the basic approach of the Office is to simply assume the claimed elements are contained in the references, even when such can not be proven, and when this fact is too inconvenient, to simply state that somehow one of skill in the art would have been motivated to conjure up the claimed invention. Startlingly, the Office makes these logical leaps at the same time that it decides, for the first time, that some of the claims do not meet the written description requirement and are indefinite. Thus, the Office is eager to make inferences and logical extensions in order to somehow make it appear that the references can be logically combined, and will further contort logic to fill in the gaps even when these illogical combinations of references do not teach some of the recited claim limitations, yet the Office can somehow also conjure up written description and indefiniteness rejections for claims that were not even amended in Applicant's most recent response.

Applicant respectfully suggests that the Office be held to a standard that is at least marginally close to the one the Office is applying to Applicant. For

example, if the Office suggests that a reference shows a particular feature, Applicant respectfully suggests that the particular reference should also meet the §112, first paragraph requirements, such that the reference actually teaches one of skill in the art that which the Office suggests, and that the reference is sufficiently enabling such that finders of fact could logically conclude that one of skill in the art would have been motivated (at the time of the invention and not based on hindsight reconstruction) to come up with the claimed invention based on the teachings in the references. Applicant respectfully submits that if the Office's rejections are subject to this scrutiny, they will surely fail. Unfortunately, it appears that Applicant will be forced to go through the expense and hassle of an appeal process in order to obtain that which Applicant has paid for – a fair and objective review of Applicant's claims.

In the present Office Action, all of the rejections are based on brand new theories. It appears as if the Office's primary concern is not to follow the rules, but to follow a different rule – "We will not allow this patent to issue no matter what!" Therefore, whenever Applicant acts in good faith in an attempt to advance this application, the Office merely moves to a new approach, or conjures up a new illogical basis for rejecting the claims. A simple review of this application file will reveal that this case has been pending for over six years (seven, if one includes the provisional application period), and the Office has yet to properly issue a final rejection. The Office tried a few times, yet each time Applicant was put in the uncomfortable position of having to explain the rules to the Office. Here, in this Office Action, it is more of the same. Instead of sticking to a theory, the Office flexes to brand new theories when it concludes that the previous rejections are not proper.

At the moment, Applicant could think of many ways to possibly amend the claims to make them comply with some particular idiosyncrasies of the Office. However, Applicant is left with the sense that no matter what Applicant does, the Office has no intention to ever act in good faith to allow this application to issue.

Therefore, Applicant is hesitant to propose any possible claim amendments, or to suggest any other course of action, as Applicant does not believe they will be fairly considered. If Applicant's conclusion is mistaken, and if the Examiner has some suggestions regarding ways to advance prosecution, Applicant respectfully requests the Examiner contact applicant to discuss any such suggestions.

In fact, if the Office reviews the history of this application, the Office will note that Applicant has been fairly prompt in scheduling interviews, calling the Examiner, and responding to Office Actions. In the present instance, however, such is not the case, and Applicant is filing for (and paying for) a three-month extension of time. This extended period is a result of Applicant taking extra time to try to figure out what to do. How does one act when a government agency fails to do its job? Obviously, were this the private sector, Applicant could simply take his business elsewhere. Here, however, Applicant theoretically has the opportunity to appeal, yet the Office continues to issue non-final rejections. Each time the Office issues a new non-final rejection, it should be safe to presume that the Office has its act together this time, and that the issues are sufficiently defined, such that when Applicant addresses the issues set forth in the Office Action, the Office will issue a Notice of Allowance. Instead, the history of this application is that each time Applicant addresses the issues set forth in the Office Action, the Office then conjures up brand new bases for rejection. This piecemeal approach is not proper and should end.

Substantively, the new primary reference, NevadaBusiness.com, comprises a one-page article containing fewer than 300 words. It simply states that there will be an on-line mayoral debate, where the "candidates are expected to field pre-set questions about Nevada's future and spontaneous questions from Nevada reporters and Las Vegas citizens." The article further states that the debate will offer "the ability for Las Vegas residents to view and participate in the event from a location they choose – from their homes, for example." That's it. That is the primary reference that supposedly teaches volumes to one of ordinary

skill in the art. That is also the primary reference that somehow enables – or, more correctly, would have enabled at the time of the invention without the benefit of hindsight – one of skill in the art to make and use the presently claimed invention. It seems ironic that the Office is willing to rely on such a thin and facially deficient primary reference at the same time the Office decides, for the first time, to discuss §112, first paragraph. If the Office at all tried to view this new primary reference through the §112, first paragraph prism, the deficiencies would be crystal clear.

All the reference says is that two political candidates will have an on-line debate, and that the public can participate. Since the reference is so thin -- it does not even say how the public will participate, for example -- the Office appears to view this as a golden opportunity to fill in the blanks with whatever it wants. Some initial questions that need to be asked include what does this reference have to do with on-line dispute resolution? Or, how does this reference teach one of skill in the art how to make and use the claimed invention? Startlingly, the first rejection over this reference is even characterized as an anticipation rejection. To add to the absurdity, the Office is able to conclude that this extremely thin reference anticipates the exact same claims that the Office rejects under §112, first paragraph. Therefore, at the same time that the Office is willing to state that Applicant's 25 pages of specification and 10 drawings don't show that Applicant had possession of these claims sufficient to meet the written description requirement, it is somehow able to conclude that this extremely thin one-page reference would have been sufficient to enable one of skill in the art to make and use the invention.

From the top – claim 37 recites a “method of resolving a dispute.” There is nothing in the reference about resolving a dispute. The Office appears to decide that since it is a mayoral debate, the fact that the candidates are debating is sufficient to equate this to the dispute described in the present application and claimed in the present claims. The Office's analysis on this critical point

comprises the following summary statement: "NevadaBusiness.com discloses a method of resolving a dispute (Debate)." The logical leap taken by the Office is to equate a debate, or discussion, with dispute resolution. What is the dispute that is resolved by this reference? There is none. Thus, the Office Action appears to want to change Applicant's claim to read "A method of discussing an issue, comprising:" If such were the case, Applicant might suggest that the claim be narrowed to recite a method of resolving a dispute. However, the claim already says this. Quite simply, the reference fails to teach, or enable, in any way, a method of resolving a dispute. Further, the logical leaps continue as each of the limitations in the claim deal with dispute resolution, while the reference simply talks about an on-line discussion. In a 102 rejection, no less. Thus, the reference does not teach parties to a dispute providing input related thereto, substantial real-time interaction directed towards resolving the dispute, and real-time interaction between a third party and one of the parties to the dispute. This rejection, therefore, should be reconsidered and withdrawn.

Claims 38 and 39 depend from claim 37, and are therefore allowable for similar reasons. In particular, claim 38 recites that the substantial real-time interaction directed towards resolving a dispute and the third party interaction occur at substantially the same time. There is no suggestion for this in the reference. This is an example of how the Office attempts to take advantage of the thinness of the reference by just assuming, with the benefit of hindsight, that it's all in there. The office simply says "(Chat Technology)" to cover this aspect of the claim. However, the reference is so thin it does not even make it clear whether the debate is in written or audio form. Presuming it is in written form, the Office is content to say that the fact that there is a chat between political candidates and their constituents, that this somehow teaches the claimed invention.

The logical leaps taken by the Office, and their impropriety, are apparent if one considers this issue in more detail. As discussed above, the claim is

directed to dispute resolution, and applicant submits that an on-line debate (regardless of whether it is oral or written – although we have no clue which one it is) between candidates is not the same as the recited dispute resolution. Claim 37 includes a limitation that is directed to the Gallery, as described in the patent application. These are the people who just want to watch the dispute resolution process, but do not want to participate. This could be similar to folks sitting in the back of a courtroom. Who are these folks in the reference? If the Office is somehow making the leap that the mayoral debate resolves a dispute – i.e., the mayoral election (which it does not), then who are the claimed Gallery members? If the “Las Vegas citizens” are somehow the logical equivalent of the Gallery, then who is the logical equivalent of the jury? And, how does the Office contend that this reference teaches one of skill in the art to have non-jurors interact in real time while the dispute resolution process is also occurring (claim 38). The logical failures of trying to use this reference, whether alone as in this 102 rejection, or in combination as in the 103 rejections, are glaring.

Claim 40 is another independent claim that is also rejected as anticipated by this single reference. Without going into the same level of detail, Applicant respectfully points out that the reference in no way teaches or enables anything to do with dispute resolution, and in no way teaches anything to do with a display of a person who is not a party, a judge or a juror.

All of the other claims are rejected as obvious over some combinations of references. All of these rejections are based on the above-discussed reference as the primary reference, and Applicant respectfully suggests that this is not a proper primary reference, such that all of these rejections should be withdrawn.

For example, claim 1 is rejected as obvious over NevadaBusiness.com in view of Herz. In the “method of resolving a dispute” recited in claim 1, there is recited a limitation that the “publicly accessible on-line form includes a dispute related advertising field including an advertisement that is selected by a computer based system.” The Office looks to Herz to supply this missing piece,

as it readily admits that the primary reference does not teach such a thing. Of course the primary reference could not be expected to teach such a thing, as it teaches very little, and is merely directed to an on-line debate between political candidates. Herz simply teaches that conceptually it is possible to have an advertisement that is related to the subject matter of a particular on-line session. There is no suggestion, whatsoever, for how an artisan of ordinary skill would conceive of adding such a feature to NevadaBusiness.com. This combination does not work.

Somehow, the Office is of the opinion that had an artisan of ordinary skill, at the time of the invention, read the entire 260+ words of NevadaBusiness.com, and also reviewed Herz, that said artisan would have been motivated to create an on-line dispute resolution system and to include a dispute related advertising field. With only the teachings of these two references, the Office is suggesting that the claimed invention would have been obvious to said artisan. Applicant respectfully submits that, in fact, the claimed invention would not have been obvious to anyone, based on these two references, and that the artisan would have no way of thinking of the claimed invention.

Claim 2 depends from claim 1, and is patentable for the reasons provided above. However, claim 2 also includes a further limitation "comprising the step of at least one of the parties providing payment information for use in obtaining a fee associated with the service of providing the resolution related information." For this claim, the Office simply concludes that the non-workable combination of NevadaBusiness.com and Herz can be further modified, and it would have been obvious to do so, by incorporating the teachings of another reference that discloses collecting payment information. As with the other §103 rejections in this case, since there is no legitimate basis to make this combination, the Office does not even attempt to provide one. Instead, the Office simply says "therefore, it would have been obvious . . . " The Office relies upon the teachings of the present invention, and not the prior art, to provide the basis for this combination,

simply stating that this combination is obvious “for the advantage of providing a method of interactively settling disputes [which is taught in the present application, but nowhere in any of the references] with the ability to maintain the system/method as a source of income [not at all suggested in the primary reference] by providing charging users for the business service [there is no business service in the primary reference, and it makes no sense to try to incorporate one]”. In the previous quote, the words in brackets are Applicants response to those of the Office.

Claims 9 and 10 are subject to a similar piecemeal rejection. In this case, the Office magically glues together the primary reference, Sloo and Siefert. Sloo is offered to teach the claimed limitation of allowing at least some of the people who access the on-line form to interact therewith based on an assessment of the person's knowledge of the law or the facts. There is absolutely no reason why one would ever think of incorporating such a thing into the primary reference. Siefert is relied upon to teach the concept of reassessing (in the words of the Office) the knowledge level. Again, these are interesting references, but they have nothing to do with the primary reference, and there is no practical way to combine them into the primary reference, let alone a particular way that would have been obvious to an ordinarily-skilled artisan.

Claims 23, 25-27, 29, 32 and 34-36 are also rejected over the combination of the primary reference and Herz. This is the same combination used to reject claim 1. The arguments associated with the rejection of claim 1 also apply to these rejections. As with the rejection of claim 1, the Office improperly equates the on-line political debate of the primary reference with the dispute resolution method of the recited claims. Further, this string of rejections is consistent with the previous ones, in that the Office fills in the blanks by making things up. For example, where claim 25 recites that “the other person is a third party other than one of the parties to the dispute,” the Office simply states “Las Vegas Public.” However, this is problematic for the Office, because claim 26 recites “further

comprising the step of enabling another third party to view the dispute without enabling the other third party to interact with the parties.” For this, the Office states that “it would have been obvious . . . to simple turn off the Public “Chat” access . . . for the advantage of increasing efficiency.” Why? It is clear that the Office will twist things in any way possible to avoid giving these claims a fair examination. Why would it have been obvious to do this, at the time of the invention, based on these references? Given a thorough understanding of the teachings of the present invention, if one were able to go back in time they could turn off access, as it is true that technology existed at the time to control access. However, the Office seems to think that just because the technology existed to do something it would have been obvious to do so; and to do so in exactly the way claimed based on the teachings of these references. This is not the case, and this is not the proper way to examine patent claims.

Claim 29 states that the input is in written form. Here, again, the Office is in a difficult position. Because the primary reference is so thin, it is not clear how the primary reference teaches or suggests that input be provided. Interestingly, the Office recognizes this by stating “As per Claim 29, NevadaBusiness.com and Herz fail to expressly disclose wherein the input is in written form.” So, in this case, the claim is rejected and the Office admits the references don’t teach the claim limitation.

Claim 24 is also rejected under this same combination. Here, the claim recites “wherein the other person is a juror.” The Office recognizes that the references fail to teach this limitation. However, the Office decides that this limitation is non-functional, and therefore chooses to give it no weight. Although Applicant has met some non-functional jurors, it is not appropriate for the Office to take the position that a juror is not functionally involved in the dispute resolution process. It would sure make the job of the Office easier if it could simply decide that integral aspects of recited claim limitations simply don’t matter, such that the prior art need only teach or suggest most of the limitations in order

to support a rejection. In fact, however, had the present application not been in existence, there is no evidence that anyone, including employees of the Office, would have thought of the concepts included in the specification and claimed in these claims. All of the limitations matter, and this rejection is improper.

Claim 28 stands rejected as obvious over NevadaBusiness.com, Herz, and another new political debate related reference – ZipLink. The Office relies on ZipLink to teach the limitation “wherein the interaction comprises a vote on which party should prevail.” The ZipLink reference is a one-and-one-half page article relating to a Presidential debate between candidates Bob Dole and Bill Clinton. The broadcast is said to allow viewers to vote on candidate performance during and directly following the debate. As with the other references, this is an interesting article, but it has nothing to do with dispute resolution. The fact that people could vote on-line with respect to a presidential debate is not the same as the claimed dispute resolution process, and although it might be convenient for the Office to ignore the stark differences between the two, it is not true that one of ordinary skill in the art would be motivated in any way to come up with the claimed dispute resolution method by simply understanding the combined references. Instead, the artisan would simply know that political debates exist on-line, that viewers can vote on candidate performance, and that there are mechanisms to intelligently select advertisements. How these three things add up to motivation to create the claimed invention is a mystery that the Office has not solved.

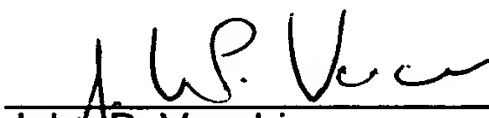
Finally, claims 8, 21, 22, 30 and 31 stand rejected over the salad of references beginning with the same primary reference – NevadaBusiness.com, and adding in Herz, Sloo and Siefert. As with earlier claims, Sloo is relied upon to teach “pre-qualifying the judge and jurors.” (Interestingly, the jurors now seem to be functional, unlike in the rejection of claim 24) As to why one would be motivated to think of pre-qualifying the “public” that is “viewing” a political debate, the Office can merely express hindsight based on the teachings of the present

application. Siefert is relied upon to teach the assessment and education of those that are being pre-qualified. Again, this does not fit with the primary reference. The Office recognizes that none of these four references teach assessing a person's knowledge of the law and/or the facts. Applicant submits that this helps show the stark difference between the recited invention and the applied art. Instead, the Office postulates that these limitations are immaterial as they are only nonfunctional descriptive data. This is not true. When you resolve a dispute, you have judges and jurors, and you expect judges and jurors to know the law and/or the facts. When you simply have people viewing a discussion, you don't. It is inconvenient for the Office to recognize this difference, because to do so mandates a withdrawal of all of the rejections in this case, and the issuance of a Notice of Allowance. However, the differences are real, and the Office can't simply recognize that they exist and then say that they don't matter.

A petition and fee for a three month extension of time are enclosed.

Based on the forgoing, the above-identified application is in condition for allowance.

Respectfully Submitted,



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Attached: Clean Copy of Claims